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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,225	12/05/2005	Jarmo Smahl	13162-016US1 2021973US	8066
26161 7590 01/28/2008 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER KEE, FANNIE C	
			ART UNIT 3679	PAPER NUMBER
			MAIL DATE 01/28/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/530,225	SMAHL, JARMO	
	Examiner	Art Unit	
	FANNIE C. KEE	3679	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20051205</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the filing date of April 4, 2005 shown on the oath does not match the filing date of the instant application of December 5, 2005. Which is the correct filing date?

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plastic body "4" must be shown with the correct cross-hatching to identify it as plastic or the feature canceled from claims 1 and 6. No new matter should be entered.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the gripping element comprising two straight portions such that the two straight portions are parallel on opposite sides of the connecting piece must be shown or the feature canceled from claims 1 and 6. No new matter should be entered.

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4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the gripping element comprising six straight portions must be shown or the feature canceled from claims 2 and 7. No new matter should be entered.

5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

6. The abstract of the disclosure is objected to because of minor grammatical errors, i.e., add the word --a-- between the words "with" and "threaded" in line 3 and because of the use of "for instance", and, "connecting piece may be made of plastic, for example" in line 3 as the abstract should not give examples, rather, the abstract should only provide the technical disclosure.

Correction is required. See MPEP § 608.01(b).

7. The disclosure is objected to because of the following informalities:

- a. Paragraph 4, line 5 – add the word --the-- before the words "threaded connection".
- b. Paragraph 19, line 6 - add the word --the-- before the words "threaded connection".
- c. Paragraph 19, line 12 - add the word --be-- before the word "directed".
- d. Paragraph 20, line 4 – replace the words "at the substantially same" with --at substantially the same--.

Correction is required.

***Claim Objections***

8. Claims 1 and 6 need to be re-written according to rule CFR 1.75(i) – “where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.”

9. The claims are replete with grammatical and idiomatic errors. All claims should be reviewed and corrected.

Correction is required.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Claim 1 recites “at least one gripping element on the outer surface of the connecting piece...the gripping element comprises at least two straight portions such that two straight portions on *opposite sides of the connecting piece are parallel*, the straight portions forming gripping surfaces for a tool, and *a portion which is arranged smooth between adjacent straight*

*portions...* [sic, emphasis added]”. It is unclear what Applicant is setting forth, i.e., claiming, as his invention and what Applicant is showing in his drawings.

In Figure 1, it is unclear how the gripping element comprises two straight portions which form gripping surfaces for the tool but which are located on opposite sides of the connecting piece. Figure 1 shows ribs located on the left side of the figure which would provide gripping surfaces on a tool, however, these are not located on opposite sides of the connecting piece. Figure 3 shows smooth surfaces on opposite sides of the connecting piece, however, these do not provide gripping surfaces for a tool. Also, Figure 3 does not have what can be termed “a portion which is arranged smooth” between the straight portions of Figure 3. Rather, there are ribs located in the center of the figure.

It is unclear what Applicant’s invention is supposed to be as what Applicant is claiming and what Applicant is showing do not correlate. The structural elements claimed by Applicant are not shown in Applicant’s own drawings.

Claim 6 recites “at least one gripping element on the outer surface of the connecting piece...the gripping element comprising at least two straight portions such that two straight portions on *opposite sides of the connecting piece are parallel*, the straight portions forming gripping surfaces for a tool and *a portion which is arranged smooth between adjacent straight portions* [sic, emphasis added]”. It is unclear what Applicant is setting forth, i.e., claiming, as his invention and what Applicant is showing in his drawings.

In Figure 1, it is unclear how the gripping element comprises two straight portions which form gripping surfaces for the tool but which are located on opposite sides of the connecting

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piece. Figure 1 shows ribs located on the left side of the figure which would provide gripping surfaces on a tool, however, these are not located on opposite sides of the connecting piece.

Figure 3 shows smooth surfaces on opposite sides of the connecting piece, however, these do not provide gripping surfaces for a tool. Also, Figure 3 does not have what can be termed "a portion which is arranged smooth" between the straight portions of Figure 3. Rather, there are ribs located in the center of the figure.

It is unclear what Applicant's invention is supposed to be as what Applicant is claiming and what Applicant is showing do not correlate. The structural elements claimed by Applicant are not shown in Applicant's own drawings.

12. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Examples of such errors are:

- e. "at at least one end of the connecting piece a metal insert provided with a thread" (claim 1, line 5).
- f. "whereby at least one element is connectable to the connecting piece with threaded connection and at least one gripping element on the outer surface of the



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connecting piece for rotating the connecting piece or keeping it still upon making the threaded connection" (claim 1, lines 6-8).

g. "at at least one end of the connecting piece a thread" (claim 6, line 4).

Claims 1 and 6 recite "wherein the gripping element comprises at least two straight portions". What does Applicant mean by "straight portions"? Straight as relative to what and in what sense? It is unclear how Applicant is defining the word "straight". Is Applicant defining the word straight as in axially straight, radially straight or perpendicularly straight? Examiner is interpreting the word straight to mean that any convenient straight surface will meet the limitations of these claims.

Claims 1 and 6 recite "a portion which is arranged smooth between adjacent straight portions". What does Applicant mean by "arranged smooth"? Does Applicant mean that the portion is straight or has a particular surface? How is it arranged? Is Applicant trying to indirectly claim a method or process step? Also, what does Applicant mean by the word smooth? Smooth as relative to what and in what sense? Examiner is interpreting this to mean that any convenient smooth surface will meet the limitations of these claims.

Claims 1 and 6 also generally recite "whereby the gripping element is formed such that the tool round the gripping element slips before the thread and/or the basic structure of the connecting piece gets damaged". Is Applicant trying to claim the tool? Applicant has not shown a tool. It appears that Applicant is indirectly claiming the tool along with the gripping element

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which has the “gripping surfaces” for a tool. Examiner is interpreting that to meet the limitations in this claim, as long as the gripping surfaces of the gripping element are met, it will not be necessary to have a tool to meet this limitation of the claims.

Claims 3 and 8 recite “wherein the gripping element is formed or two or more ribs in the direction of the periphery of the connecting piece”. What does Applicant mean by this statement? What is Applicant defining as the periphery? Does Applicant mean the edge of the piece? Which edge is Applicant referring to? Examiner is interpreting this to mean that any convenient edge would be a periphery and would meet this limitation of these claims.

Claim 4 recites “wherein the outer surface of the metal insert is provided with ribs in the direction of the periphery, the ribs of the metal insert and the ribs on the outer surface of the connecting piece being arranged at the same point [sic]”. The ribs of the metal insert are “in the direction of the periphery”. What periphery is Applicant referring to? The periphery of what? Is Applicant referring to the periphery of the metal insert or the connecting piece or the gripping element? Or does Applicant mean any edge of any of the pieces? Also, what does Applicant mean by arranged at the same point? Does Applicant mean that they meet at the same point or touch at the same point? Or does Applicant mean that they are directed in the same direction? Also, is Applicant speaking to the same ribs as the ribs in claim 3? Applicant has only previously defined in claim 3 that the ribs of the gripping element are formed in the direction of the periphery of the connecting piece, not that the ribs of the gripping element are the same as ribs on the outer surface of the connecting piece. Is Applicant speaking to other ribs present on

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the connecting piece? Are the ribs on the outer surface of the connecting piece formed in a particular direction? As best understood, Examiner is interpreting that the ribs on the outer surface of the connecting piece are the same ribs as the ribs on the gripping element. Also, Examiner is interpreting that the ribs of the metal insert are formed in the direction of any edge that would define a periphery. Examiner is interpreting that as long as the ribs of the metal insert are formed in the direction of a periphery of the connecting piece and the ribs on the outer surface of the connecting piece, i.e., the ribs of the gripping element, are formed in the direction of the connecting piece, the limitation that they are "arranged" at the same point has been met.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

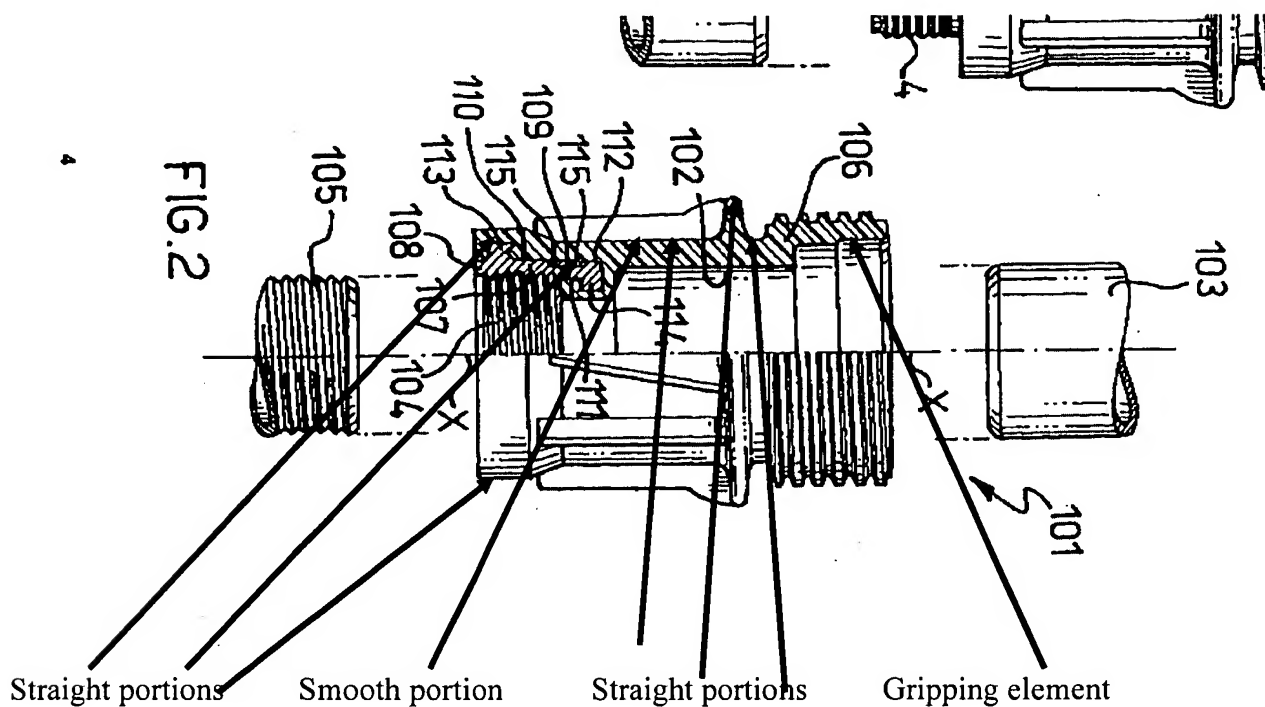
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Mazzacano et al EPO Patent No. EP 0 870 970 A2.

With regard to claim 1, and as best understood by Examiner, Mazzacano et al disclose a connecting piece (101), intended for connecting at least two elements, whereby a first element (105) is connected to a first end of the connecting piece and a second element (103) is connected to a second end of the connecting piece, the connecting piece being comprising a body (106)

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mainly of plastic, at least one end of the connecting piece a metal insert (108) provided with a thread (104), whereby at least one element is connectable to the connecting piece with threaded connection and at least one gripping element on the outer surface of the connecting piece for rotating the connecting piece or keeping it still upon making the threaded connection, that the gripping element comprises at least two straight portions such that two straight portions on opposite sides of the connecting piece are parallel, the straight portions forming gripping surfaces for a tool, and a portion which is arranged smooth between adjacent straight portions, whereby the gripping element is formed such that the tool round the gripping element slips before the thread and/or the basic structure of the connecting piece gets damaged (see Figure 2 below).



With regard to claim 2, and as best understood by Examiner, Mazzacano et al disclose the gripping element comprising six straight portions (see Figure 2 above).

With regard to claim 3, and as best understood by Examiner, Mazzacano et al disclose the gripping element being formed of two or more ribs in the direction of the periphery of the connecting piece (see Figure 2 above).

With regard to claim 4, and as best understood by Examiner, Mazzacano et al disclose the outer surface of the metal insert being provided with ribs (113, 114) in the direction of the periphery, the ribs of the metal insert and the ribs on the outer surface of the connecting piece being arranged at the same point (see Figure 2).

With regard to claim 5, and as best understood by Examiner, Mazzacano et al disclose the portion which is arranged smooth being a rounded portion (see Figure 2 above).

*Claim Rejections - 35 USC § 103*

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzacano et al.

With regard to claim 6, and as best understood by Examiner, Mazzacano et al disclose a connecting piece (101), intended for connecting at least two elements, whereby a first element (105) is connected to a first end of the connecting piece and a second element (103) is connected to a second end of the connecting piece, the connecting piece comprising a body (106), at least one end of the connecting piece a thread (104), whereby at least one element is connectable to the connecting piece with threaded connection and at least one gripping element on the outer surface of the connecting piece for rotating the connecting piece or keeping it still upon making the threaded connection, the gripping element comprising at least two straight portions such that two straight portions on opposite sides of the connecting piece are parallel, the straight portions forming gripping surfaces for a tool and a portion which is arranged smooth between adjacent straight portions, whereby the gripping element is formed such that the tool round the gripping element slips before the thread of the connecting piece gets damaged (see Figure 2 above).

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However, Mazzacano et al disclose that the body is mainly of plastic but do not expressly disclose that the plastic is thermoplast.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the body of thermoplastic because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

With regard to claim 7, and as best understood by Examiner, Mazzacano et al disclose the gripping element comprising six straight portions (see Figure 2 above).

With regard to claim 8, and as best understood by Examiner, Mazzacano et al disclose the gripping element being formed of two or more ribs in the direction of the periphery of the connecting piece (see Figure 2 above).

With regard to claim 9, and as best understood by Examiner, Mazzacano et al disclose the portion which is arranged smooth being a rounded portion (see Figure 2 above).

*Conclusion*

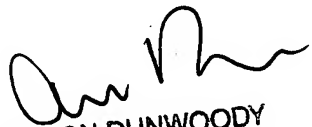
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fannie C. Kee whose telephone number is (571) 272-1820. The examiner can normally be reached on 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Fannie C. Kee  
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